

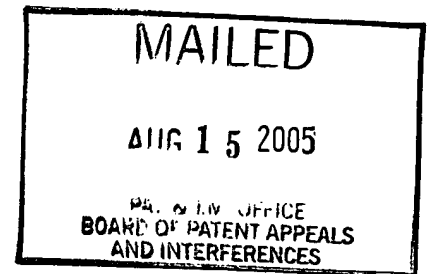
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ALISTAIR R. HAMILTON

Appeal No. 2005-1322  
Application No. 09/181,151



ON BRIEF

Before JERRY SMITH, GROSS, and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-14, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for establishing an audio-video conference.

Representative claims 1 and 2 are reproduced as follows:

1. A method of establishing an audio-video conference, comprising the following steps:

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..  
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- a) holding an audio-only conference;
- b) displaying static visual images during the audio-only conference; and
- c) holding an audio conference accompanied by a live video conference.

2. A method of establishing an audio-video conference, comprising the following steps:

- a) setting up an audio-video conference on a high-bandwidth communication channel;
- b) during the setting-up step, holding an audio conference using a POTS channel; and
- c) after setting up completes
  - i) holding the audio-video conference on the high-bandwidth channel; and
  - ii) terminating the audio conference on the POTS channel.

The examiner relies on the following references:

Dagdeviren et al. (Dagdeviren)	5,371,534	Dec. 06, 1994
Partridge, III (Partridge)	H1714	Mar. 03, 1998
Morino et al. (Morino)	JP 09-023414	Jan. 21, 1997

Claims 2, 5, 6, 8 and 10 stand rejected under 35 U.S.C.  
§ 102(b) as being anticipated by the disclosure of Dagdeviren.  
Claims 1, 3, 4, 7, 9 and 11-14 stand rejected under 35 U.S.C.  
§ 103(a). As evidence of obviousness the examiner offers  
Dagdeviren in view of Partridge with respect to claims 1, 3, 4, 7,

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9 and 14, and Dagdeviren in view of Morino with respect to claims 11-13.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports the rejection of claims 1, 3, 4, 7, 9 and 14, but does not support the rejection of claims 2, 5, 6, 8 and 10-13. Accordingly, we affirm-in-part.

We consider first the rejection of claims 2, 5, 6, 8 and 10 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Dagdeviren. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of

inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

These claims have been indicated to stand or fall together as a single group [brief, page 3], and we will consider independent claim 2 as the representative claim for this group. The examiner has indicated how he reads the invention of claim 2 on the disclosure of Dagdeviren [answer, page 6]. Appellant argues that Dagdeviren fails to disclose the step of holding an audio conference using a POTS channel. Appellant asserts that the voice grade trunks in Dagdeviren are not POTS channels, but instead, are B-channels of a digital ISDN line [brief, pages 23-26]. The examiner responds that the voice grade channel of Dagdeviren meets the claimed POTS channel [answer, pages 7-8]. Appellant responds that the voice grade call disclosed by Dagdeviren is not a POTS call, but instead, is a call placed on a digital line [reply brief, pages 5-10].

We will not sustain the examiner's anticipation rejection of claims 2, 5, 6, 8 and 10. Although the examiner continually

reiterates his position that the voice grade call in Dagdeviren uses a POTS channel as claimed, the examiner never addresses appellant's argument that Dagdeviren specifically teaches that the voice grade call is made on an ISDN channel, and therefore, cannot be a POTS call. We agree with appellant's argument. Dagdeviren specifically teaches that when an audio-video call is to be made, the initial audio call is carried over a communication path consisting of one of the logical channels of the digital loop of each video phone and the voice grade trunks interconnecting the switches serving the video phones [column 2, lines 62-68]. Dagdeviren also teaches that the bearer channel freed by the termination of the voice grade call is reused as the second channel for the enhanced video call [column 3, lines 60-62]. This suggests to us that the voice grade channels in Dagdeviren must be capable of carrying the signals required for an enhanced video call when an audio-video call is to be made. We agree with appellant that a POTS channel would be incapable of carrying such signals. Therefore, there is no support for the examiner's bald assertion that the voice grade channel in Dagdeviren is a POTS channel. Although Dagdeviren teaches single medium POTS channels, these POTS channels would be used for regular audio calls only. Claim 2 recites an audio-video conference call. As noted above, a digital channel is used for such calls in Dagdeviren, and not the POTS

channels. Since the examiner's rejection is based on anticipation only, we have not considered the question of whether it would have been obvious to the artisan to make the initial audio call in Dagdeviren for an audio-video conference using a POTS channel as claimed.

We now consider the rejections of the claims under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

We consider first the rejection of claims 11-13 based on Dagdeviren and Morino. Since these claims all depend from claim 2, and since the examiner's rejection relies on the erroneous finding that Dagdeviren teaches a POTS channel for audio-video conference calls as discussed above, then the rejection clearly fails to establish a prima facie case of obviousness. Therefore, we do not sustain the examiner's rejection of claims 11-13.

We now consider the rejection of claims 1, 3, 4, 7, 9 and 14 based on Dagdeviren and Partridge. These claims stand or fall together as a single group except for claim 14 which is argued separately [brief, page 3]. Therefore, we will consider this rejection with respect to claims 1 and 14 only. With respect to claim 1, the examiner finds that Dagdeviren teaches the claimed invention except for displaying static visual images during the audio only conference. The examiner cites Partridge as teaching this feature. The examiner finds that it would have been obvious to the artisan to display static images in Dagdeviren during the audio call as this would enable call screening based on the calling party's image as taught by Partridge [answer, pages 3-4].

Appellant argues that the examiner's proposed combination of Dagdeviren and Partridge is not based on actual evidence, is not contained within the prior art, and is not clear and particular. Specifically, appellant argues that there is no valid teaching given for combining the references. Appellant argues that the reason given by the examiner for combining the teachings of the prior art has several problems. Among the problems advanced by appellant are 1) the lack of a suggestion for making the proposed combination; 2) Partridge already has call screening so Dagdeviren is not needed; 3) the proposed combination would change the principle of operation of Dagdeviren; 4) the teachings of the

references are contrary to each other; 5) the references implement fundamentally different approaches; 6) the references cannot be combined; 7) the references are contradictory; 8) the modification proposed by the examiner would render Dagdeviren inoperative; and 9) the combination of references actually does not achieve anything. Appellant also argues that even if the references are combined, all the limitations of claim 1 are not present because claim 1 recites a single conference and plural images whereas Partridge only shows a single picture. Finally, appellant argues that even if the references are combined, the recitation in claim 1 clause c) is only found if Dagdeviren operates in a certain way [brief, pages 7-23].

The examiner responds that Partridge teaches the advantage of sending a static image along with a call so the called party can use the image for call screening purposes. The examiner asserts that this advantage is sufficient motivation to add static images to the calls made in Dagdeviren. The examiner also responds to each of the problems identified by appellant in the brief by pointing out the errors the examiner perceives in appellant's arguments. Finally, the examiner points out the combination of the references teaches every feature of claim 1 [answer, pages 7-14].

Appellant responds that the presence of an element in a reference does not act as a teaching for combining that element

with another reference. Appellant reiterates his position that the teaching of Partridge is contrary to Dagdeviren and would defeat the purpose of Partridge [reply brief, pages 2-3 and 10-14].

We will sustain the examiner's rejection of representative claim 1 and of claims 3, 4, 7 and 9 which are grouped therewith. Appellant's arguments for the most part are unpersuasive because they are primarily based on contradictions between the teachings of Dagdeviren and Partridge when all the teachings of Dagdeviren are combined with all the teachings of Partridge. The rejection, however, relies on adding a single small feature of Partridge to the system taught by Dagdeviren. Specifically, Dagdeviren teaches setting up a conference call by first completing an audio only call [column 2, lines 63-64]. Regardless of whether or not an audio-video conference is ultimately established, the rejection simply proposes to add the sending of static images to this initial audio call in Dagdeviren so that the called party would be able to screen calls based on these static images. The ability to screen audio calls is an advantage taught by Partridge which is unavailable in the system taught by Dagdeviren. We agree with the examiner that the advantage of call screening taught by Partridge provides sufficient motivation for adding this feature to Dagdeviren. This would permit the called party in Dagdeviren to screen calls and choose to ignore the attempted conference. Thus, the modification

proposed by the examiner provides a call screening advantage to the system of Dagdeviren and does not suffer any of the problems asserted by appellant.

With respect to the recitation in claim 1 that plural static images are displayed during the audio-only conference, we agree with the examiner that Partridge provides for this feature. Partridge teaches that more than one image, such as a slide show, may be used [column 2, lines 61-65]. Thus, when the teachings of Partridge are applied to the system of Dagdeviren, the initial audio only call would be accompanied by a plurality of static images as taught by Partridge for call screening purposes.

With respect to separately argued claim 14, appellant argues that the examiner's basis for the modification, that is, the enhancement of Dagdeviren's system is not supported by the prior art. Appellant argues that adding Partridge to Dagdeviren changes the mode of operation of Partridge [brief, pages 28-29]. The examiner responds that Partridge teaches using a plurality of images as part of the call screening advantage taught therein [answer, page 16]. Appellant responds that enhancement is not an appropriate basis for combining references [reply brief, page 16].

We will sustain the examiner's rejection of claim 14. As noted above, the "enhancement" of Dagdeviren suggested by Partridge is that sending static images along with an audio call allows the

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called party to perform call screening based on the image of the calling party. As also noted above, the advantage of obtaining call screening by the called party as taught by Partridge provides sufficient motivation for the artisan to add this feature to the system of Dagdeviren.

In summary, we have not sustained the examiner's rejection of claims 2, 5, 6, 8 and 10 under 35 U.S.C. § 102, or the rejection of claims 11-13 under 35 U.S.C. § 103, but we have sustained the examiner's rejection of claims 1, 3, 4, 7, 9 and 14 under 35 U.S.C. § 103. Therefore, the decision of the examiner rejecting claims 1-14 is affirmed-in-part.

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with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART


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